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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,463	10/15/2001	William C. Johnson JR.	GEO-55	3692
7590 01/24/2006			EXAMINER	
Milton Wolson 11 Martine Avenue 12th Floor White Plains, NY 10606			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,463

Applicant(s)

JOHNSON, WILLIAM C.

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6 and 8-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 5,6 and 8-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 5, 6, 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to claims 5 and 6, the limitation "in its compressed state" is an addition of new matter. There appears to be no support for this limitation in the specification as originally filed. As seen on page 4, lines 18-24, specifically lines 22-24, "The thickness of cold weather insulation layer 20 may, for example, vary between .75 inches and 1.00 inches. It will be appreciated that the uncompressed cold insulating layer 20 provides superior cold weather insulation than does the compressed cold weather layer 4 of the prior art boot ." This passage does not designate whether the insulation layer is measured in its compressed state or its uncompressed state. Therefore, the assumption of the uncompressed state has no support. With respect to claim 11, the limitation that "a thinner layer of cold insulating material extending below the second side of the lining" has no support in the specification because this limitation does not appear to be located anywhere in the specification as originally filed. Furthermore, the same applies to the water-impermeable layer recited in claim 12.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over international reference to Techboot WO 92/14372 (WO '372) in view of White 3,805,419. WO '372 discloses all the limitations substantially as claimed including the following: a boot (see Figure 2); an outer layer 35 of stretchable leather (leather in and of itself is stretchable); an oversized toe box 27 supported on the outsole (see Figures 1-4, shows the toe box resting on the outsole) and covered by the layer of stretchable leather 35; the toe box being sized to enclose a substantial thickness of compressible cold insulating material and the corresponding portion of the user's foot without compression of the cold insulating material when the boot is worn (see page 5, lines 1-10, the toe cap is spaced "relatively high of the foot at the rear" to allow for flexibility of the foot and prevent rubbing of the toe cap against the top of the user's foot.); a layer of compressible cold insulating material in its uncompressed state (a layer of compressible cold insulating material 43 secured to the inside of the toe box in an uncompressed state); a lining 34 having a first side facing the opposing surface of the cold insulating material (see Figures) and a second side generally facing the upper surface of a portion of a user's foot (lowermost side of the insulating material); the lining extending below the opposing surface of the cold insulating material (lining attached to sole and not compressing the insulating layer to the protector); an outsole 10. WO '372 does not disclose the insulating material being located but not being compressed between the toe box and a lining or the cold insulating material having a surface secured to the underside of the toe box. White '419 teaches that an insulating layer 5 for a toe protected boot can be located, uncompressed, between the toe box 1 and the lining 6 to provide air absorption and cushioning to the user's foot during use. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place an insulating layer between the toe box and the liner of WO '372, as taught by White '419, to aid in protecting and cushioning the user's foot while insulating the boot as well. White '419 further discloses a toe cap 1 with

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a layer of cushioning material 5 attached to the under side of the toe cap by an adhesive 3 attaching the under side of toe cap with the top surface of the cushioning material. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to attach the cushioning material to the toe cap by adhesive, as taught by White '419, to prevent the cushioning material from moving during flexing of the shoe during use. .

5. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 92/14372 in view of White 3,805,419 as applied above further in view of Applicant's admission of obviousness. WO '372 in view of White 3,805,419 as applied above discloses all the limitations substantially as claimed except for the thickness of the insulating material. Official Notice was taken that it would be obvious to one of ordinary skill in the art, at the time the invention was made, to make the insulating material any thickness to insulate the boot to the hold the desired temperature. Applicant failed to argue the obviousness of the Official Notice and therefore appears to agree with the obviousness. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the insulation layer of WO '372 the desired thickness to insulate the boot to the desired temperature to keep the user's feet warm in cold temperatures.

6. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over White 3,805,419 or Adams 4,102,062 in view of the references as applied to claim 10 above.

White '419 disclose all the limitations substantially as claimed including the following: a boot (see Figure 1) having an outer layer 8 stretched over an oversized toe box 1 located beneath the outer layer; a layer of compressible cold insulating material 5 secured to the inside of the toe box in an uncompressed state (fastened to sole therefore not compressing uncompressed layer 5 to toe cap); a lining 6 extending below the compressible cold insulating material so that the cold insulating material is not

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compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 9.

Adams '062 discloses all the limitations substantially as claimed including the following: a boot (see Figure 1) having an outer layer 11 stretched over an oversized toe box 13 located beneath the outer layer; a layer of compressible cold insulating material 25 secured to the inside of the toe box in an uncompressed state (fastened to sole and not shown compressed between liner and toe box); a lining 24 extending below the compressible cold insulating material so that the cold insulating material is not compressed (lining attached to sole and not compressing the insulating layer to the protector); an outsole 14. White '419 teaches that an insulating layer 5 for a toe protected boot can be located, uncompressed, between the toe box 1 and the lining 6 to provide air absorption and cushioning to the user's foot during use. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place an insulating layer between the toe box and the liner of WO '372, as taught by White '419, to aid in protecting and cushioning the user's foot while insulating the boot as well.

Neither White '419 nor Adams '062 discloses the outer layer being leather or the thickness of the insulating layer. WO '372 teaches that a leather exterior boot can have a toe box, insulating layer and lining located beneath the outer leather layer of a work boot to aid in insulating the user's foot from cold weather. Therefore, it would have been obvious, in view of WO '372, to make the boot used in each of White '419 or Adams '062 out of leather, as taught by WO '372, to aid in protecting the user's foot from impacts.

With respect to the limitations of the thickness of the insulating layer, Official Notice was taken that it would be obvious to one of ordinary skill in the art, at the time the invention was made, to make the insulating material any thickness necessary to insulate the boot to hold the desired temperature. Applicant failed to argue the obviousness of the Official Notice and therefore appears to agree with the obviousness. Therefore, it would have been obvious, to one of ordinary skill in the art, to make the insulation layer of

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WO '372 the desired thickness to insulate the boot to the desired temperature to keep the user's feet warm in cold temperatures.

7. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 10 above. Since the toe boxes of the references as applied above are intended to cover different sized shoes, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to vary the size of the toe box to fit the size of the shoe being used, including a height of 1.9 inches and a length of 2 inches, so that the foot within the shoe is properly protected.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 10 above in view of Hill 2,814,888. The references as applied to claim 10 disclose all the limitations of the claim except for the thinner layer of cold insulating material extending below the second side of the lining. Hill '888 teaches that a pad 16 can be located under the lining and above another lining layer to add to cushioning of the toecap with respect to the user's toes. The pad would be another layer that would retard cold air from getting to the user's foot. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to add as many layers of insulating material under the toe cap, of the references as applied to claim 10 above, to give the desired comfort of the user.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Aumann 5,689,903. The references as applied to claim 11 above disclose all the limitations of the claim except a layer of water-impermeable, water-vapor permeable membrane extending below the layer of cold insulating material. Aumann '903 teaches that it is desirable to have a layer of water-impermeable, water-vapor permeable material L (see col. 2, lines 32-37) located adjacent the user's foot in the toe area of the shoe to allow water vapor from the perspiration of the user's foot to escape without allowing water (i.e. waterproofing) to enter the shoe through the material. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a

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water-impermeable, water-vapor permeable material next to the user's foot, as taught by Aumann '903, to allow for the user's foot to breathe without building up perspiration.

Response to Arguments

10. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS